

## REMARKS

Office Action states that Claim 7 and Claim 8 are objected to because of the following informalities.

Claim 7, line 1, "9" should be 6.

Claim 7 has been amended to correct the informality.

Claim 8, line 1, "wireless" should be deleted.

Applicant respectfully traverses.

Claim 8 has been amended to correct erroneous claim dependence.

Currently amended Claim 8 claims dependence upon Claim 6, thereby obviating the need to delete "wireless."

Claims 1-4, 6-13, and 15-23 remain pending in this patent application. Claims 5, 14, and 24, have been cancelled. Claims 1-4, 6-13, and 15-23 stand rejected. Applicant respectfully requests further examination and reconsideration in view of the arguments set forth below.

### 35 U.S.C. § 102 Rejections

Claims 1-5, 10-16, and 21-24, are rejected under 35 U.S.C. § 102 (b) as being anticipated by Harari, et al., United States Patent 5,887,145. Applicant has reviewed the cited art and for the following rationale assert that Claims 1-4, 6-13, and 15-23, distinguish over these references under 35 U.S.C. § 102 (b).

Rejection states, with reference to Claims 1, 10, and 21, that Harari, et al., discloses a removable mother/daughter card comprising: a first module 10 having an opening, said first module adapted to be communicatively coupled with an electronic device 200, said first module adapted to receive a second module 20, a controller 40 coupled with said first module for controlling communication between said first module and said second module, a first module electrical connector 12 to communicate with said electronic device, and a second connector coupled with the first module for communicating with the second module (see Figures 1-3 and col. 6, line 59 +)

Currently amended Claim 1 recites the following limitations:

A intermediary apparatus adapted to be communicatively coupled with an electronic device, said electronic device having an externally disposed accessible slot, said intermediary apparatus comprising:

a first module having an opening, said first module adapted to be communicatively coupled with said electronic device, said first module adapted to receive a second module, said first module a communication device;

a controller coupled with said first module, said controller for controlling communication between said first module and said second module, provided said second module is inserted into said first module, said second module a compact memory device;

a first electrical connector coupled with said first module, said first electrical connector adapted to enable communication between said first module and said electronic device; and

a second electrical connector coupled with said first module, said second electrical connector adapted to enable communication between said first module and said second module, provided said second module is inserted into said first module.

Currently amended Claim 10 recites the following limitations:

A system having an electronic device and an intermediary apparatus, said electronic device having an externally disposed accessible slot, said intermediary apparatus communicatively coupled with said electronic device, said intermediary apparatus comprising:

a first module having an opening, said first module adapted to receive a second module, said first module a communication device;

a controller coupled with said first module, said controller for controlling the communication between said first module and said second module, provided said second module is inserted into said first module, said second module a compact memory device;

a first electrical connector coupled with said first module, said first electrical connector adapted to enable communication between said first module and said electronic device; and

a second electrical connector coupled with said first module, said second electrical connector adapted to enable communication between said first module and said second module, provided said second module is inserted into said first module.

Currently amended Claim 21 recites the following limitations:

In a system having an electronic device, wherein said electronic device having an externally disposed accessible slot, and an intermediary apparatus adapted to be communicatively coupled with said electronic device, a method for improved user interoperability comprising the steps of;

providing a first module comprising a opening, said opening adapted to receive a second module, said first module adapted to be inserted into said accessible slot of said electronic device, said first module a communication device;

providing a first electrical connector adapted to enable communication between said first module and said electronic device;

providing a second electrical connector adapted to enable communication between said first module and said second module, provided said second module is inserted into said first module, said second module a memory device;

providing a controller coupled with said first module, said controller adapted to control communication between said first module and said second module, provided said second module is inserted into said first module;

inserting said first module into said electronic device; and  
inserting said second module into said first module.

The claimed embodiments, as recited in currently amended Claims 1, 10, 21, recite, in part, an intermediate apparatus comprising a first module and a second module. The first module is adapted to be inserted in an electronic device having an externally disposed accessible slot. The first module has an opening for receiving the second module. The first module is a communication device. The second module is a compact memory device.

Therefore, as claimed, an intermediate apparatus having a first and second module in which the second module is insertable in the first module and in which the first module is insertable in an electronic device is provided. The first module is a communication device and the second module is a compact memory device.

The cited art, as understood by Applicant, does not teach a first module being a communication device adapted to receive a second module in which the second module is a compact memory device.

Harari, as understood by Applicant, suggests a mother/daughter card (10/20) insertable into a host system 200. Harari, as understood by Applicant, further suggests that daughter card 20 can be a memory device, a magnetic hard disc, or a communication device (Figure 5A). Harari, as understood by Applicant, suggests that a mother card 10 may have memory disposed thereon (Figure 6 and 7) and which may receive a daughter card 20 that may be a communication device. However, Harari, as understood by Applicant, does not suggest a mother card 10 as a communication device, e.g., a modem.

By Harari suggesting, as understood by Applicant, a daughter card 20 as a communication device, Harari, as understood by Applicant, describes overcoming acknowledged shortcomings of a Harari mother card 10 which is not envisioned, suggested, described, or taught as a communication device.

In contrast, the claimed embodiments, as claimed in currently amended Claims 1, 10, and 21, require an intermediate apparatus in which a first module can be implemented as a communication device.

### 35 U.S.C. § 103 Rejections

Claims 9 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. The teachings of Harari have been discussed above.

Rejection states that Harari fails to disclose or fairly suggest the opening of the first module is larger than accessible slot of electronic device. However, such limitation is an obvious engineering design choice to meet customer's requirements, failing to provide any unexpected results. Furthermore, these types of connection combinations are notoriously old and well known in the art. Therefore, it would have been an obvious extension as taught by Harari.

Applicant respectfully traverses. Applicant's claimed invention recites, as recited in Claims 1, 10, and 21, the limitations of an intermediary apparatus comprising a first and a second module in which the first module is insertable in an externally accessible slot disposed on an electronic device and in which the second module is inserted in the first module in which the first module may be a communication device and the second module may be a compact memory device. Applicant's claimed invention further recites the limitations that the opening of the first module is larger than the opening of the electronic device into which the first module is insertable.

Thus, Applicant's claimed invention is drawn to providing a first module that can be inserted into a external slot disposed on an electronic device and into which can be inserted a second module where the second module would not be enabled to communicate with the electronic device as the external slot is smaller than the size of the second module, e.g., a compact memory device. As substantiated in the instant application, the first module may be configured to be inserted into a external slot, e.g., a memory stick type slot. The opening in the first module can be configured to receive an SD (secure digital) or an MMC (multi media card) or alternative compact memory device. Thus, Applicant's claimed invention provides an apparatus that enables communication between an electronic device and a second module, e.g., a compact memory device, in which the electronic device was not originally configured to interact with the second module, thereby providing improved

interoperability. Additionally, as recited in currently amended Claims 1, 10, and 21, the first module can be a communication device into which a second module, e.g., a compact memory device, can be inserted, enabling access and transfer of the data contained in the second module with an electronic device or other electronic devices communicatively coupled therewith.

Claims 6-8 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Nelson et al, US Patent No. 6, 377,218. Applicant has reviewed the cited references and for the following rationale assert that Claims 10, 12, and 14-15 distinguish over these references under 35 U.S.C. § 103 (a).

Nelson, as understood by Applicant, suggests an antennae that is coupled to a radio frequency (RF) device disposed upon a peripheral component. Because Harari, as understood by Applicant, suggests a daughter card 20 that can be a communication device, Harari, as understood by Applicant, suggests communication circuitry and components disposed on a daughter card 20. As such, modifying the teachings of Harari with the teachings Nelson dispose an antennae on a daughter card 20 configured as a communication device. However, the modification of the teachings of Harari with the teaching of Nelson do not remedy the shortcomings of Harari, in that Harari in view of Nelson does not provide a first module configurable as a communication device into which a second module, configurable as a compact memory device, can be inserted.

Continuing, combining the Harari daughter card 20 with the antennae of Nelson does not enable a memory card to be inserted into a communication device, as recited in Claims 1, 6-8, 10, 17-19, etc. Further, Harari, as understood by Applicant, suggests in detail those components and circuitry that are to be disposed on a mother card 10 which are configured for memory device interaction but in which Harari, as understood by Applicant,

does not suggest, describe, or teach, incorporating communication circuitry or components for wireless communication. This is substantiated by Harari, as understood by Applicant, to configure a daughter card 20 as a communication device. Thus, there is no motivation to modify the teachings of Harari (mother card 10) with the antennae of Nelson. Further, extensive modification of a mother card 10, not described therein, would be required to accommodate the teachings of Nelson.

## CONCLUSION

In light of the above arguments and remarks, Applicant respectfully requests reconsideration of rejected Claims 1-4, 6-13, and 15-23.

Based on the amendments, arguments, and remarks presented above, Applicant respectfully asserts that Claims 1, 10, and 21 are allowable under 35 U.S.C. § 102 (b), and that all remaining dependent claims (i.e., Claims 2-4, 6-9, 11-13, 15-20, and 22-23 ) depend from allowable base claims. As such, Applicant respectfully solicits allowance of all remaining claims.

Further, based on the arguments and remarks presented above, Applicant respectfully asserts that Claims 6-9 and 17-20 are allowable under 35 U.S.C. § 103(a). As such, Applicant respectfully solicits allowance of all remaining claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present application.

Respectfully submitted,

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